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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,286	06/01/2005	Masashi Gotoh	273043US3PCT	1853
22850	7590	07/15/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER HARRISON, MONICA D	
			ART UNIT	PAPER NUMBER
			2813	
			NOTIFICATION DATE	DELIVERY MODE
			07/15/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com  
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<b>Office Action Summary</b>	<b>Application No.</b> 10/537,286	<b>Applicant(s)</b> GOTOH ET AL.	
	<b>Examiner</b> Monica D. Harrison	<b>Art Unit</b> 2813	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 10-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/20/08 and 6/23/08</u> .                                     | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. Applicant's amendment filed 6/23/08 has been entered.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Kitamura et al (5,480,048).

2. Regarding claim 10, Kitamura et al discloses a method for manufacturing an electronic part in which a layer having a uniform thickness is formed, the method comprising: forming at least one conductor portion (Figure 15b, references 1502 and 1503 )on a surface of a support member (Figure 15b, reference 1501); bringing an insulating sheet into contact with the at least one conductor portion from above (Figure 15c, reference 1504); and pressing the insulating sheet by a pressurizing means to a height of the at least one conductor portion using the at least one conductor portion as a stopper (Figure 15c, reference 1503) to make the height of the insulating sheet equal to the height of the at least one conductor portion (Figure 15d).

3. Regarding claim 11, Kitamura et al discloses wherein said at least one conductor portion and said insulating sheet are detached from said surface, after making the height of said insulating sheet equal to the height of said at least one conductor portion (Figure 4a).

4. Regarding claim 12, Kitamura et al discloses wherein said support member is a substrate of said electronic part (Figure 15b, reference 1501).

5. Regarding claim 13, Kitamura et al discloses wherein a B-stage sheet is used as said insulating sheet (Figure 15c, reference 1504).

6. Regarding claim 14, Kitamura et al discloses wherein a B-stage sheet is used as said insulating sheet (Figure 15A, reference 1504).

7. Regarding claim 15, Kitamura et al discloses wherein a thermoplastic insulating sheet is used as said insulating sheet (Figure 1e, reference 107).

8. Regarding claim 16, Kitamura et al discloses wherein a thermoplastic insulating sheet is used as said insulating sheet (Figure 1e, reference 107).

9. Regarding claims 17-22, Kitamura et al discloses wherein heating is performed in addition to said pressing (column 31, lines 10-20).

10. Regarding claim 23, Kitamura et al discloses a method for manufacturing an electronic part in which a layer having a uniform thickness is formed, the method comprising: forming a power supply film (Figure 15b, reference 1502) on a surface of a support member (Figure 15b, reference 1501); forming at least one conductor portion by plating using the power supply film as an electrode (Figure 15b, reference 1503); bringing said insulating sheet into contact with the at least one conductor portion from above (Figure 15c, reference 1504); pressing by a pressurizing means the second support member including the insulating sheet to the height of the at least one conductor portion using said at least one conductor portion; and removing said power supply film (Figure 15d).

11. Regarding claim 24, Kitamura et al discloses wherein said conductor portion and said insulating sheet are detached from said surface, after making the height of said insulating sheet equal to the height of said conductor portion (Figure 4a).

12. Regarding claim 25, Kitamura et al discloses wherein said support member is a substrate of said electronic part (Figure 15c, reference 1501).

13. Regarding claim 26, Kitamura et al discloses wherein a B-stage sheet is used as said insulating sheet (Figure 15c, reference 1504).

14. Regarding claim 27, Kitamura et al discloses wherein a B-stage sheet is used as said insulating sheet (Figure 15c, reference 1504).

15. Regarding claim 28, Kitamura et al discloses wherein a thermoplastic insulating sheet is used as said insulating sheet (Figure 1e, reference 107).

16. Regarding claim 29, Kitamura et al discloses wherein a thermoplastic insulating sheet is used as said insulating sheet (Figure 1 e, reference 107).

17. Regarding claims 30-35, Kitamura et al discloses wherein heating is performed in addition to said pressing (column 31, lines 10-20).

### ***Response to Arguments***

18. Regarding claims 10-35, the applicant has overcome U.S.C 112, 1<sup>st</sup> however, previously admitted prior art still reads on the instant application Kitamura et al (5,480,084).

### ***Conclusion***

19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica D. Harrison whose telephone number is (571)272-1959. The examiner can normally be reached on M-F 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead Jr. can be reached on 571-272-1702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Monica D. Harrison/  
Examiner, Art Unit 2813

mdh  
7/7/08

/Laura M Menz/

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